

Claim 3 (previously presented): The method according to claim 2 in which the first fixation assembly includes a clamp for mounting a plurality of pins each for engaging with the first bone, said plurality of pins being spaced along the length of the first fixation assembly.

Claim 4 (previously presented): The method of claim 1 in which the first fixation assembly includes engagement means for engaging at least one bone pin, the engagement means being rotatable about a longitudinal axis of the first fixation assembly.

Claim 5 (previously presented): The method of claim 1 in which the first fixation assembly includes engagement means for engaging at least one bone pin, the engagement means being rotatable about a transverse axis of the first fixation assembly.

Claim 6 (previously presented): The method of claim 2 in which the first fixation assembly includes engagement means for engaging at least one bone pin, the engagement means being independently rotatable about a longitudinal axis and a transverse axis of the first fixation assembly.

Claim 7 (previously presented): The method according to one of claims 1-6 in which the first fixation assembly is coupled to the link assembly by way of a first pivot in a manner selected from the group consisting of those having one and two degrees of rotation freedom.

Claim 8 (canceled)

Claim 9 (previously presented): The method according to claim 1 in which the link assembly includes a fixed separation member for maintaining said first and second pivots at a fixed distance of separation.

Claims 10-14 (canceled)

Claim 15 (previously presented): The method according to claim 1 further including means for varying separation of the first fixation assembly and the second fixation assembly as a function of the angular displacement of either fixation assembly relative to the link assembly.

Claim 16 (previously presented): The method according to claim 1 further including a drive member coupled to the first fixation assembly and to the second fixation assembly for controllably varying the angular displacement of the first and second fixation assemblies relative to one another.

Claim 17 (canceled)

Claim 18 (previously presented): The method according to claim 1 further including a sensor adapted to monitor the load applied across the link assembly.

Claim 19 (previously presented): The method according to claim 18 in which the sensor is adapted to monitor any one of the tensile load, compression load, shear forces or bending forces applied across the link assembly.

Claim 20 (previously presented): The method according to claim 19 in which the sensor comprises a strain gauge.

Claim 21 (previously presented): The method according to any one of claims 1 to 6 comprising a pair of link assemblies each pivotally anchored to both the first and second fixation assemblies and laterally displaced from one another.

Claims 22-23 (canceled)

Claim 24 (previously presented): The method according to claim 1 further including a second corresponding apparatus for coupling thereto by a plurality of bone pins.

Claims 25-34 (canceled)

Claim 35 (previously presented): The method according to claim 1, wherein the link assembly includes a spring.

Claim 36 (previously presented): The method according to claim 1, wherein each of the first and second pivots have multiple degrees of freedom during use.

Claim 37 (cancel)

Claim 38 (cancel)

Claim 39 (previously presented): The method according to claim 1, wherein the first and second pivots carry load so that the apparatus provides reduction of pressure on the joint.

REMARKS

By this paper, claims 37 and 38 have been canceled. Claims 1-7, 9, 15, 16, 18-21, 24, 35, 36 and 39 are pending.

Objection to Specification

In the Office Action dated June 15, 2009, the specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. In that regard, the Office Action states that the terms “in-line” and “non-sliding” recited in claims 37 and 38, respectively, were not supported by the specification. Although it is believed that the drawings support the recitation of these terms in the claims, claims 37 and 38 nevertheless have been canceled to advance prosecution of the present application. Accordingly, it is believed that the objection to the specification has been traversed.

Claim Rejections – 35 U.S.C. § 112

Additionally, in the outstanding Office Action, claim 38 was rejected under 35 U.S.C. § 112, first paragraph. In so rejecting claim 38, the Office Action states that “it is noted that the term ‘non-sliding’ can be interpreted very broadly, and that the word sliding merely refers to motion that is smooth and continuous. Because the term ‘non-sliding’ is not defined in the specification and the word ‘sliding’ can be interpreted broadly, the recitation in claim 38 is being considered new matter.” As stated, claim 38 has been canceled to advance the prosecution of the present application and as such, the Section 112, first paragraph rejection of claim 38 is obviated.

Moreover, claims 1-7, 9, 15, 16, 18-20, 24 and 35-39 were rejected under 35 U.S.C. § 112, second paragraph. Here, the Office Action states that “The term ‘relatively full mobility’ in claim 1 is a relative term which renders the claim indefinite. The term ‘relatively full mobility’ is not defined by the claim, the specification does not provide a standard for

ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.”

It is respectfully submitted, however, that each of the pending claims satisfy the requirements of Section 112, and second paragraph.

It is believed to be significant that MPEP 2173.05(a) states that “The requirements for clarity and precision must be balanced with the limitations of the language and science. If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute (35 U.S.C. § 112, second paragraph) demands no more.” *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613 (Fed. Cir. 1985). In fact, the MPEP states that “If the proposed language is not considered as precise as the subject matter permits, the examiner should provide reasons to support the conclusion with indefiniteness and is encouraged to suggest alternatives that are free from objection.”

As to the meaning of claim terms, MPEP 2111.01 states that “the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification.” *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371 (Fed. Cir. 2004); (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say.) Significantly, “the ordinary customary meaning of a claim is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the application.” *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005); *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298 (Fed. Cir. 2003); *Brookhill-Wilke I, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294 (Fed. Cir. 2003); (“In

the absence of any express intent to impart a novel meaning to the claimed terms, the words are presumed to take on ordinary customary meanings attributed to them by those of ordinary skill in the art.”) Also, the MPEP provides “If more than one extrinsic definition is consistent with the use of the words and the extrinsic record, the claimed terms may be construed to encompass all consistent meanings.” *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336 (Fed. Cir. 2001).

Here, it is respectfully submitted that the phrase “relatively full mobility” recited in claim 1 is indeed a definite phrase, one that particularly points out and distinctly defines a subject matter which the Applicant regards as the invention. As stated above, the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification and simple English words whose meaning is clear and unquestionable are to be construed to mean exactly what they say. Further, clarity and precision of claim terminology must be balanced with the limitations of language and the science, and should such language reasonably apprise those skilled in the art as to meaning, Section 112 demands no more.

As it concerns the present claims, it is respectfully submitted that the phrase “relatively full mobility” would mean “substantially full mobility” and from the perspective of a physician practicing the claimed method, the recitation in claim 1 of “said apparatus provides reduction of pressure on at least a portion of the joint without substantially resisting an angular displacement associated with relatively full mobility of the first and second bones of the joint to thereby treat arthritic conditions affecting the joint” means not clinically hampering the angular displacement of the joint.

Therefore, it is respectfully submitted that each of the pending claims also satisfy the requirements of Section 112, second paragraph.

CONCLUSION

In view of the above, Applicant respectfully requests that the application be reconsidered, the claims allowed and the application passed to issue.

Respectfully submitted,

STEPTOE & JOHNSON, LLP

/John V. Hanley/

John V. Hanley

Registration No. 38,171

JVH:kst
Steptoe & Johnson, LLP
2121 Avenue of the Stars, Suite 2800
Los Angeles, CA 90067
Telephone: (310) 734-3200
Facsimile: (310) 734-3300